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REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 18, 2005. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

1. Response to Rejection of Claims 1-35 and 7-14 Under 35 U.S.C. § 102(e)

Claims 1-3 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Dutta* (U.S. Patent Publication No. 2002/0135800). Applicants respectfully traverse this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Dutta* reference. Applicants discuss the *Dutta* reference and Applicants' claims in the following.

a. Claim 1

As provided in independent claim 1, Applicants claim:

A method comprising: receiving a user selection of one or more print options via a network service, wherein the one or more print options are identified for subsequent resolution, and wherein the one or more print options can be applied to a plurality of other network services, the print options serving to configure a printer in a particular manner for printing.

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Dutta* does not disclose, teach, or suggest at least the features of "receiving a user selection of one or more print options via a network service, wherein the one or more print options are identified for subsequent resolution, and wherein the one or more print options can be applied to a plurality of other network services, the

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print options serving to configure a printer in a particular manner for printing," as recited and emphasized above in claim 1.

Rather, *Dutta* discloses at most a system that "allows a user to choose one or more print options in order to conserve the consumption of physical resources, such as paper and printer ink, by modifying the content of a document." Para. 0081.

Accordingly, *Dutta* teaches:

By parsing the document and changing the structure, tags, elements, element attribute values, text, graphics, etc., of the document, the present invention creates a modified document that consumes less physical resources during the physical printing process than would the physical printing process of the unmodified document. Although the resulting hardcopy may be only a roughly approximate version of the original document, the user obtains representative hardcopies for particular purposes while minimizing the printing costs, thereby potentially saving significant amounts of paper and/or printer ink or printer toner.

Para. 0081.

Therefore, *Dutta* modifies an underlying document in lieu of configuring a printer in a particular manner. As a result, *Dutta* does not teach or suggest at least the claimed limitations of "receiving a user selection of one or more print options via a network service, wherein the one or more print options are identified for subsequent resolution, and wherein the one or more print options can be applied to a plurality of other network services, the print options serving to configure a printer in a particular manner for printing," as recited in claim 1. Therefore, claim 1 is not anticipated by *Dutta*, and the rejection should be withdrawn for at least this reason alone.

b. Claims 2-3

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-3 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that the dependent claims 2-3 contain all the steps and features of independent claim 1. For at least this reason, the rejection of claims 2-3 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for allowability of claims 2-3, these claims recite further features and/or combinations of features (as is

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apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Accordingly, the rejections to these claims should be withdrawn.

2. Response to Rejection of Claims 4-25 Under 35 U.S.C. § 103(a)

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Potts, Jr.* (U.S. Patent No. 6,314,432). Claims 5, 6, 8-10, 13-18, and 22-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Davis* (U.S. Publication No. 2002/0059489). Claims 7 and 11-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Davis* in further view of *Potts, Jr.* Claims 19-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Dutta* in view of *Potts, Jr.* in further view of *Davis*. Applicants respectfully traverse these rejections.

a. Claim 4

In the present case, the cited art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the cited art to modify the references to include those limitations. For example, neither *Potts, Jr.* nor *Davis* teaches or suggests "storing the one or more print options as associated with the user-selected name; and allowing subsequent selection of the one or more print options by the user based on the user-selected name," as recited in claim 4. To illustrate, *Potts, Jr.* apparently discloses that printing options may be limited to a specific directory such that web pages are only printed if they are located within the specific directory. See col. 6, lines 13-29. Therefore, a prima facie case establishing an obviousness rejection by *Dutta* in view of *Potts, Jr.* has not been made, since stored print options are not capable of being selected based upon a user-selected name. Thus, claim 4 is not obvious under the proposed combination of *Dutta* in view of *Potts, Jr.*, and the rejection should be withdrawn for at least this reason alone.

b. Claims 5-8

Regarding claim 5, *Dutta* appears to modify an underlying document in lieu of configuring a printer in a particular manner. As a result, *Dutta* does not teach or suggest at least the claimed limitations of "making the selected print options subsequently available to the user for configuring of a plurality of printers," as recited

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in claim 5. Further, *Potts, Jr.* does not remedy the deficiencies of the *Dutta* reference. Therefore, claim 5 is patentable over *Dutta* in view of *Potts, Jr.*, and the rejection should be withdrawn for at least this reason alone

Because independent claim 5 is allowable over the cited art of record, dependent claims 6-8 (which depend from independent claim 5) are allowable as a matter of law for at least the reason that the dependent claims 6-8 contain all the steps and features of independent claim 5. For at least this reason, the rejection of claims 6-8 should be withdrawn. Additionally and notwithstanding the foregoing reasons for allowability of claims 6-8, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record.

As one illustrative example, among others, neither *Potts, Jr.* nor *Davis* teaches or suggests "wherein each of the plurality of print options is not specific to a particular printer," as recited in claim 6. To illustrate, *Davis* discloses that "application 42 sends the document to file manager 44 [in remote computer 24] with specific destination printer and print option information" . . . and "prints it on remote printer 26." Para. 0025-0026. Therefore, a prima facie case establishing an obviousness rejection by *Dutta* in view of *Davis* has not been made. Thus, claim 6 is not obvious under the proposed combination of *Dutta* in view of *Davis*, and the rejection should be withdrawn for at least this reason alone.

c. Claims 9-14

Regarding claim 9, *Dutta* appears to modify an underlying document in lieu of configuring a printer in a particular manner. As a result, *Dutta* does not teach or suggest at least the claimed limitations of "another graphical mechanism via which the user can indicate a desire to save the selected print options as associated with the identifier and for subsequent provision to a plurality of printers, the print options serving to configure a printer in a particular manner for printing," as recited in claim 9. Further, *Potts, Jr.* does not remedy the deficiencies of the *Dutta* reference. Therefore, claim 9 is patentable over *Dutta* in view of *Potts, Jr.*, and the rejection should be withdrawn for at least this reason alone

Because independent claim 9 is allowable over the cited art of record, dependent claims 10-14 (which depend from independent claim 9) are allowable as a

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matter of law for at least the reason that the dependent claims 10-14 contain all the features of independent claim 9. For at least this reason, the rejection of claims 10-14 should be withdrawn. Additionally and notwithstanding the foregoing reasons for allowability of claims 10-14, these claims recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Accordingly, the rejections to these claims should be withdrawn.

d. Claims 15-18

With respect to claim 15, *Dutta* in view of *Davis* fails to teach or suggest "receiving an indication of one of a plurality of sets of print options to be used in printing a document irrespective of a printer on which the document is to be printed" and "communicating the indicated set of print options to the indicated printer irrespective of whether the printer supports one or more of the print options identified in the set of print options," as recited in claim 15. To illustrate, *Davis* discloses that print options are communicated to a remote printer if the printer supports the print options. See para. 0032. Therefore, a prima facie case establishing an obviousness rejection by *Dutta* in view of *Davis* has not been made, since *Dutta* does not disclose the aforementioned features. Thus, claim 15 is not obvious under the proposed combination of *Dutta* in view of *Davis*, and the rejection should be withdrawn for at least this reason alone.

Further, Applicants respectfully submit that the "printer discovery" process disclosed in *Davis* suggests a process whereby an application determines which printers are available for printing a document and does not cover the feature of "communicating the indicated set of print options to the indicated printer irrespective of whether the printer supports one or more of the print options identified in the set of print options," as disclosed in claim 15. For at least this reason, the rejection of claim 15 should also be withdrawn.

Additionally, claims 16-18 recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Accordingly, the rejections to these claims should be withdrawn.

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e. Claims 19-21

Regarding claim 19, neither *Potts, Jr.* nor *Davis* teaches or suggests "a printer configuration user interface, communicatively coupled to the network interface, wherein the printer configuration user interface is configured to allow a user of a client interface to select print options and group the selection together as a configuration associated with a particular name, and wherein the printer configuration user interface is further configured to allow the user to select print options without regard for print options supported by a printer that the user can subsequently print to, the print options serving to configure the printer in a particular manner for printing," as recited in claim 19. To illustrate, *Potts, Jr.* apparently discloses that printing options may be limited to a specific directory such that web pages are only printed if they are located within the specific directory. See col. 6, lines 13-29. Further, *Davis* discloses that "application 42 sends the document to file manager 44 [in remote computer 24] with specific destination printer and print option information" . . . and "prints it on remote printer 26." Para. 0025-0026. Therefore, a prima facie case establishing an obviousness rejection by *Dutta* in view of *Potts, Jr.* in further view of *Dutta* has not been made. Thus, claim 19 is not obvious under the proposed combination, and the rejection should be withdrawn for at least this reason alone.

Accordingly, claims 19-21 recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Accordingly, the rejections to these claims should be withdrawn.

f. Claims 22-25

Since *Dutta* teaches modifying an underlying document in lieu of configuring settings within a printer, *Dutta* in view of *Davis* fails to teach or suggest "for each option in the set of desired print options, applying the setting corresponding to the option if the printer supports the print option, and ignoring the setting corresponding to the option if the printer does not support the print option," as recited in claim 22.

Further, Applicants respectfully submit that the "printer discovery" process disclosed in *Davis* suggests a process whereby an application determines which printers are available for printing a document and does not cover the step of "ignoring

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the setting corresponding to the option if the printer does not support the print option," as disclosed in claim 22.

Additionally, claims 23-25 recite further features and/or combinations of features (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Accordingly, the rejections to these claims should be withdrawn.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,


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